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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,108	06/02/2000	Neil A Willcocks	02280.002620.	6805

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FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
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PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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04/28/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/587,108	<b>Applicant(s)</b> WILLCOCKS ET AL.	
	<b>Examiner</b> THIERRY L. PHAM	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-65 and 83-97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-65, 83-97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

- This action is responsive to an amendment filed on 1/21/09.
- Claims 31-65, 83-97 are currently pending; claims 1-30, 66-82 have been canceled.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-65, 83-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Over et al (US 6538767).

Regarding claim 31, Over discloses a system (system 1, fig. 2) for enabling consumer (users or customers, col. 6, lines 5-8) to submit a customizable image (receiving customizable image or personalized image from consumer's computer remotely via LAN, WAN, Internet, col. 6, lines 5-17) to be printed directly on a non-planar surface (non-planar surfaces including ornaments, baseball, basketball, cups, blocks, cylinders, eggs, and etc, col. 5, lines comprising:

- a computer (imaging system 20, fig. 2), adapted to communicated (via LAN, WAN, or Internet communication network, col. 6, lines 5-15) with consumer's computer and enable the consumer's computer to communicate image data via a network (customizable image or personalized image from consumer's computer remotely via LAN, WAN, Internet, col. 6, lines 5-17); and
- an ink-jet printer (ink-jet printer system 10, fig. 1, col. 5, lines 35-36) adapted to receive the image data from the computer and print directly on a non-planar surface (non-planar surfaces, col. 5, lines 1-17) a high quality image having a resolution greater than about 200 dpi (at least 360 dpi, col. 11, lines 15-40) that corresponds to the received image data in the manufacture of personalized objects (non-planar objects with personalized message or image, col. 6, lines 1-17), *but Over does not specifically teach and/or suggest the object to be printed with personalized image is either a sugar shell candy or jellybean.*

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Over's disclosure can be used to print on various types of objects and surfaces (e.g. spherical objects, semi-spherical objects, curve surfaces objects, non-linear surfaces, and such objects include ornaments, baseball, basketball, golf balls, tennis balls, soccer balls, footballs, eggs, baseball hats, cups, blocks, and cylinders, col. 5, lines 1-17), *wherein both the objects and inks can also be "edible"* (col. 3, lines 13-15, col. 5, lines 45-48, and col. 7, lines 13-17).

Since system as taught by Over is able to print customized/personalized images (col. 6, lines 5-17) on any objects (e.g. edible and non-edible objects, col. 5, lines 40-47) and any surfaces (planar and non-planar surfaces, col. 5, lines 2-17). Therefore, it would have been obvious to print customized/personalized image on an "edible" objects including *sugar shell candy or jellybean*.

Regarding claim 32, Over further discloses a system according to Claim 31, wherein the network is the Internet (col. 6, lines 9-10). Over does not specifically teach and/or suggest a Web Browser runs on consumer computer adapted to send and receive Hypertext Markup Language (HTML) forms over the World Wide Web. Since system as taught by Over is implemented via using Internet and wherein Web Browser such as Internet Explorer or Netscape is widely available and well known installed on most consumer computer, therefore, it would have been obvious to include Web Browser on consumer/customer's computer that enable consumers/customers to send personalized image to manufacturer via using World Wide Web (Web Browser).

Regarding claim 33, Over further discloses a system according to Claim 31, wherein the network is a local area network (fig. 1).

Regarding claim 34, Over further teaches a system according to claim 31, wherein the ink-jet printer prints on the sugar shell or jellybean using a dispersed pigment food-grade ink (edible inks, col. 5, lines 1-49) to obtain a printed image having resolution greater than 200 dpi (col. 11, lines 25-40) even if printed using a single printhead and single pass printing.

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Regarding claim 35, Kofman further discloses ink-jet printer is a drop-on-demand ink-jet printer (drop-on-demand ink-jet printer is well known and widely used in the print arts).

Regarding claim 36, Over further teaches wherein the printed image has a resolution between 300 and 1200 dpi (col. 11, lines 25-40).

Regarding claim 83, Over further teaches a system according to claim 31, further comprising a subsystem for holding (fig. 1, 9-10) the sugar shell candies or jellybean transiently in position and serially (the object may be mounted on a table that rotates the object to each successive position or may be mounted on an “assembly” that moves along a straight path between the print heads, col. 3, lines 19-24) transporting them past a printhead for printing.

Regarding claim 88, Over further teaches a system according to claim 31, wherein the customizable image is a personalized message (col. 6, lines 1-17).

Regarding claim 93, Over further teaches a system according to claim 31, further comprising an image processor adapted to process the image data and to allow the consumer to preview options (image preview 108 for allowing an operator to view the graphics that are to be applied to the objects, col. 12, lines 25-30, in addition, each consumer’s computer includes a user interface display (e.g. monitor) that allows users/consumers to preview images and to adjust/modify (e.g. resize, cropping, color adjusting, and etc) the image before sending to the manufacturer) for decoration of said sugar shell candy or jellybean.

Regarding claims 37-65, and 84-87, 89-92, 94-97 recite limitations that are similar and in the same scope of invention as to those in claims 31-36, 83, and 88, and 93 above; therefore, claims 37-65, and 84-87, 89-92, 94-97 are rejected for the same rejection rationale/basis as described in claims 31-36, 83, and 88, and 93 above.

### ***Response to Arguments***

Applicant's arguments filed 1/21/09 have been fully considered but they are not persuasive.

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- Regarding claims 31-65 & 83-97, the applicants argued that the rejection under 35 USC 103(a) dated 7/18/2008 was based upon impermissible hindsight.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

- Regarding claims 31-65 & 83-97, the applicants argued the cited prior arts of record (US 6538767 to Over et al) fails to teach and/or suggest a system controlled by a consumer. Furthermore, the applicants argued the cited prior art [Over] fails teach and/or suggest wherein information entered by the customer at one location is transmitted to a computer to print finished confectionery products in an e-commerce application.

In response, the examiner disagrees. None of the claims recite features/limitations that a printing system is controlled by a consumer. For example, claim 31 includes features/limitations that enabling consumer to submit a customizable image to another computer be printed and does not include any features/limitations that suggest that the printing operation is controlled by the consumer. However, Over clearly teaches a printing system that enabling remote users (consumers) to submit "desired" graphical information to be printed on a non-planar surface (see col. 5, lines 63 to col. 6, lines 17. Cited texts from column 5, lines 63 to column 6, lines 17 are shown below with emphasis.

“An example of the printing system 10 according to a preferred embodiment will now be described with reference to FIG. 2. **The printing system 10 includes an imaging system 20 for receiving information on the desired graphics to be applied to the object.** The imaging system 20 can acquire this graphical information in any suitable manner. For instance, the imaging system 20 may receive the information directly through user input at the imaging system 20, such as through a scanner, keyboard, mouse, or other suitable

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input devices. Alternatively, the imaging system 20 may receive the graphical information from remote users or customers. For instance, the imaging system 20 may be connected to a network, such as Local Area Network (LAN) or a Wide Area Network (WAN), or the imaging system 20 may receive graphical information through the Internet. Administrators of the facility 1 can therefore remotely enter or select the desired graphical information or customers of the objects may enter or select the graphics that should be applied to their objects. The imaging system 20 may present a set of graphics from which the administrator or customer can select or can receive the graphical information from the administrator or customer".

The cited texts as shown above clearly teach an image to be printed on an object can be from an administrator or customer (transmitted remotely via using network such as Internet).

- Regarding claims 83-87, the applicants argued the cited prior art (US 6538767 to Over et al) of record fails to teach and/or suggest a sub-system wherein confectionery items are conveyed past a print head.

In response, the examiner disagrees. Over teaches a non-planar object "O" as shown in fig. 6 can be held at fixed position and rotate as the print head applies the image to the object, wherein print head is also preferably movable with respect to the ball so that the print head is at an optimal position relative to the object (see col. 3, lines 1-5). Furthermore, Over also teaches wherein the object may be mounted on an indexed table and after printing with one color the object is moved to another print head for printing of a second color (see fig. 4, col. 3, lines 13-20). Texts from the cited reference are shown below:

"The printing systems and methods according to the invention are not limited to a single color. Multiple colors may be applied to an object through the use of multiple graphics units. The invention preferably uses processed color or digital imaging which enables the printing of about 16 million colors. The inks are preferably translucent inks but may comprise any other suitable ink, such as opaque ink or even edible inks. According to one example, the object may be mounted on an indexed table and after printing with one color the object is moved to another print head for the printing of a second color. An intermediate station between the application

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*of two inks may be necessary to allow for the curing or drying of the ink. The objects may be mounted on a table that rotates the object to each successive position or may be mounted on an assembly that moves along a straight path between the print heads. Furthermore, the systems and methods according to the invention are able to maintain the object at a desired position between print heads.* Since the position of the object relative to its spin axis is always known, the images from the different colored print heads can be merged to create a desired image having virtually any color". Also see col. 3, lines 30-50 for more details.

The cited texts as shown above clearly teach the object "O" is conveyed from one print head to another print head.

- Regarding claims 31-65 & 83-97, the applicants argued the cited prior art (US 6538767 to Over et al) of record fails to teach and/or suggest customized printing on sugar shell confectionery or jellybeans.

In response, the examiner disagrees. Over teaches a method of printing personalized graphic information from a users/customers (see col. 5, lines 63 to col. 6, lines 17) on a plurality planar and non-planar surfaces (e.g. ornaments, semi-spherical objects such as golf balls, eggs, and footballs, baseballs, soccer balls, baseball bats, cups, blocks, and cylinders, see col. 2, lines 55-60 and col. 5, lines 5-18). The examiner notes in the office action that Over does not expressly teach and/or suggest printing a personalized message/graphic information on a sugar shell confectionery or jellybeans. Over's disclosure can be used to print on various types of objects and surfaces (e.g. spherical objects, semi-spherical objects, curve surfaces objects, non-linear surfaces, and such objects include ornaments, baseball, basketball, golf balls, tennis balls, soccer balls, footballs, eggs, baseball hats, cups, blocks, and cylinders, col. 5, lines 1-17), ***wherein both the objects and inks can also be "edible"*** (col. 3, lines 13-15, col. 5, lines 45-48, and col. 7, lines 13-17). Since system as taught by Over is able to print customized/personalized images (col. 6, lines 5-17) on any objects (e.g. edible and non-edible objects, col. 5, lines 40-47) and any surfaces (planar and non-planar surfaces, col. 5, lines 2-17). Therefore, it would have been obvious to print customized/personalized image on an "edible" objects including ***sugar shell***



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***candy or jellybean.*** For example, sugar shell ornament or sugar shell egg is being printed with edible inks.

- Regarding claims 31-65 & 83-97, the applicants argued the claimed invention is a commercial success due to non-obviousness.

In response, the examiner disagrees. The inkjet printing system as taught by Over can be used to print personalized message on any surfaces (e.g. spherical objects, semi-spherical objects, curve surfaces objects, non-linear surfaces, and such objects include ornaments, baseball, basketball, golf balls, tennis balls, soccer balls, footballs, eggs, baseball hats, cups, blocks, and cylinders, col. 5, lines 1-17), ***wherein both the objects and inks can also be "edible"*** (col. 3, lines 13-15, col. 5, lines 45-48, and col. 7, lines 13-17). Since system as taught by Over is able to print customized/personalized images (col. 6, lines 5-17) on any objects (e.g. edible and non-edible objects, col. 5, lines 40-47) and any surfaces (planar and non-planar surfaces, col. 5, lines 2-17). Therefore, it would have been obvious to print customized/personalized image on an "edible" objects including ***sugar shell candy or jellybean.*** For example, sugar shell ornament or sugar shell egg is being printed with edible inks.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to THIERRY L. PHAM whose telephone number is (571)272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thierry L Pham/

Examiner of Art Unit 2625

/Dov Popovici/

Primary Examiner, Art Unit 2625

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